

REMARKS

Claims 19-31 were previously withdrawn from consideration. Claims 32-36 are currently pending, with claim 32 being the sole independent claim. Claim 32 has been amended. Dependent claim 37 has been added. Support for the amendment to claim 32 may be found, for example, at pg. 2, lines 21-23 of the specification as originally filed. No new matter has been added. Reconsideration of the above-identified application, in view of the following amendment and remarks, is respectfully requested.

Claim for Priority

The Examiner has failed to indicate that the certified copy of the priority document has been received from the International Bureau. Confirmation of receipt and entry into the record of the certified copy of the priority document from the International Bureau is requested.

Rejections Under 35 U.S.C. §112, First Paragraph

Claim 36 stands rejected under 36 U.S.C. §112, first paragraph for failure to comply with the enablement requirement. According to the Examiner, "[t]he specification fails to point out what is 'an open-loop or closed-loop control unit' and what structure each of the 'an open-loop control unit' and a 'closed looped control unit' is pertained to so as to be enabling". Applicants disagree.

As explained at pg. 7, lines 11-15 of the specification as originally filed, "a common open-loop or closed-loop control unit 15 is assigned to the printing unit 10 and to the printing devices 12 and 13 integrated inline with the printing unit 10. The common open-loop or closed-loop control unit 15 thus serves to control all of the integrated inline printing units 10 and

printing devices 12 and 13". An open-loop or closed loop circuit is an old and well known concept. Indeed, applicants have described the control unit 15 as a common open-loop or closed-loop control circuit to indicate the conventionality of the claimed control circuit. The skilled person in the field of control circuits would therefore possess the requisite knowledge of such an open-loop or closed-loop control unit. The specification thus provides a sufficient written description to enable the skilled person to make and/or use the claimed invention. Withdrawal of the rejection is therefore deemed to be in order.

Rejections Under 35 U.S.C. §102

Claims 32-34 and 36 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,906,156 ("*Shibuya*"). Claims 32 and 35 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,035,782 ("*Harrod*"). For the following reasons, reconsideration and withdrawal of these rejections are respectfully requested.

The claimed invention is directed to a device for printing on a substrate that is moved through at least one printing device installed inline with a printing unit or with each printing unit. As a result, a static or unchanging image can be individualized by the addition of at least one dynamic or changing image (see pg. 2, lines 2-5 of the specification as originally filed).

As explained at pg. 2, lines 9-12 of the instant specification, "the process of individualizing the static image by adding one or more dynamic images to it is thus carried out inline and therefore in a single workflow. As a result, these types of printed articles can be produced more quickly, more easily, and more cheaply".

Independent claim 32 has been amended to recite, *inter alia*, "wherein image information from a plurality of data streams is printed inline on the substrate in a single workflow". Support

for this limitation may be found, for example, at pg. 2, line 21 - pg. 3, line 3 of the specification as originally filed. No new matter has been added. The cited art fails to teach or suggest this limitation.

Shibuya “relates to a rotary press having an additional printing apparatus and to a printing unit having an additional printing apparatus, wherein paper web is run while an image is being printed thereon by a rotating printing cylinder and wherein an additional image such as a spot image is printed thereon in alignment with the image printed by the printing cylinder” (see col. 1, lines 5-12). *Shibuya* (col. 2, line 39-41) teaches “an additional printing apparatus for a printing unit in which paper web is run while an image is printed onto the paper web by rotation of a printing cylinder”. Moreover, *Shibuya* (col. 4, lines 55-60) explains that “[a]fter leaving the additional printing apparatus, the printed paper web finally reaches the post-printing processing unit to be processed. The operation of the additional printing apparatus, i.e. additional printing, is performed under control of the control means”. The additional printing apparatus 30 of *Shibuya* is an ink jet printing device 34, which can be used for spot printing an additional image (i.e., a rising sun Japanese flag) in an ink different from that of the regular image (see col. 6, lines 30-44). According to *Shibuya*, both the regular data image and the spot image are static. Furthermore, *Shibuya* fails to disclose anything about the data streams that are used.

Since *Shibuya* discloses two static images and does not specify the data stream or streams used, *Shibuya* thus fails to teach “at least one printing unit configured to print a static or unchanging image on the substrate” and “at least one printing device, installed inline with the at least one printing unit, and configured to individualize the static image by adding at least one dynamic or changing image to the substrate”, and “a single work flow in which image information from a plurality of data streams is printed inline on the substrate, as expressly recited

in now amended independent claim 32. *Shibuya* thus fails to anticipate now amended independent claim 32.

Harrod discloses “flexographic printing wherein the anilox or inker roll is movable toward and away from the plate cylinder on a selective basis to apply ink to the plate cylinder only during printing” (see col. 1, lines 9-12). *Harrod* fails to teach or suggest anything about “wherein image information from a plurality of data streams is printed inline on the substrate in a single workflow,” as recited in now amended independent claim 32.

Harrod (col. 1, lines 51-56) merely explains, for example, that “inker roll is in contact with the plate cylinder only during printing revolutions of the plate and impression cylinders and is inhibited from contact with the plate cylinder during non-printing revolutions, thereby preventing any re-inking of the plate cylinder”. This has nothing to do with image information from a plurality of data streams that is printed inline on the substrate in a single workflow as recited in now amended independent claim 1. *Harrod* thus fails to anticipate now amended independent claim 1.

In view of the foregoing, independent claim 32 is patentable over the combination of *Shibuya* and *Harrod*. Reconsideration and withdrawal of all the rejections under 35 U.S.C. §102(b) are therefore in order, and a notice to that effect is respectfully requested.

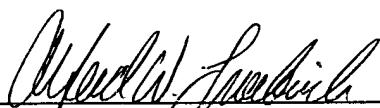
In view of the patentability of independent claim 32, dependent claims 33-36, as well as new dependent claim 37, are also patentable over the prior art for the reasons set forth above, as well as for the additional recitations contained therein.

Based on the foregoing remarks, this application is in condition for allowance. Early passage of this case to issue is respectfully requested.

Should the Examiner have any comments, questions, suggestions, or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By 
Alfred W. Froeblich
Reg. No. 38,887
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

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